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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,172	10/17/2003	Kenneth M. Kane	1700-002P/FLS	9521
22831	7590	12/15/2004	EXAMINER	
SCHWEITZER CORNMAN GROSS & BONDELL LLP 292 MADISON AVENUE - 19th FLOOR NEW YORK, NY 10017			HAN, JASON	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/688,172	<b>Applicant(s)</b> KANE ET AL.	
	<b>Examiner</b> Jason M Han	<b>Art Unit</b> 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8 and 9 is/are rejected.
- 7) ☒ Claim(s) 2-7 and 10-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1 & 8 are objected to because of the following informalities:

Applicant's arguments point out, "Such lighting fixtures typically utilize one or more disc-like accessory elements to achieve various lighting effects [underline added for emphasis]."

Within limitations (1b, 1c) and (8c), the applicant recites a "plurality" of accessory elements. Please remain consistent throughout the claims and consider rewriting to read "one or a plurality" of accessory elements. If not, then limitations (1e, 1g) and (8e, 8f, 9b) lack antecedent basis with the recitation "one or more" accessory elements.

Appropriate correction is required.

2. Claims 2 & 10 are objected to because of the following informalities:

In limitation (b), line 3: grammatical error – please rewrite "an" as "as".

Appropriate correction is required.

### ***Response to Arguments***

3. Applicant's arguments filed November 15, 2004 have been fully considered but they are not persuasive. The rejections for independent Claim 1 and independent Claim 8 with subsequent dependent Claim 9 stand and are not withheld. It is clear that the combined references read upon all the claim limitations as elucidated below.

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the examiner combined Kuchar et al. (U.S. Patent 6079992) in view of Sweet (U.S. Patent 2477705) with respect to the retaining member. It is obvious that Kuchar provides a functionally equivalent retaining member for a number of accessory elements [Column 6, Lines 29-35], but does not specifically teach the retaining member meeting the all the structural limitations of the claim(s). The examiner considers motivation for combining the Sweet reference to be one of design choice, since it is obvious that Kuchar provides a functionally equivalent retaining member.

5. In addition, the recitation "for removable and interchangeable reception" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Krop v. Robie*, 88 USPQ 478 (CCPA 1951). It should further be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Mashum*, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuchar et al. (U.S. Patent 6079992) in view of Sweet (U.S. Patent 2477705).

Kuchar discloses a media cartridge unit [Figures 12-13: (108, 116)] including:

- (a) a cartridge ring having a circular side wall [Figures 12-13: (108)] and open bottom and top portions [Figures 12-13];
- (b) a plurality of generally flat, disc-like accessory elements [Figure 12: (106); Column 6, Lines 29-32];
- (c) the side wall portions having an axial dimension sufficient in accommodating the plurality of accessory elements [Figures 12-13]; and
- (d) a bottom support flange extending inwardly [Figures 12-13: (126); Column 6, Line 59].

In addition, Kuchar teaches, "As therein shown a plurality (here three) of media accessories 106 such as, for example, a colored filter, a lens, and a louver are axially spaced within a unitary media cartridge 108, and are retained therein by the use of any suitable means such as a circular wire (not shown) received within the periphery of the cartridge [Column 6, Lines 29-35; underline added for emphasis]."

Kuchar does not specifically teach the retaining means / member(s):

(e) positioned on the side wall portion for engagement with outer edge portions of an upper one of one or more accessory elements positioned in axially stacked relation within the cartridge ring;

(f) wherein a resilient element extends inward from the side wall portions at an angle thereto such that portions of the resilient element closer to the bottom portion of the cartridge ring extend inward a distance less than portions of the resilient element farther removed from the bottom portion; and

(g) whereby the resilient element engages and resiliently bears inwardly against at least the upper one of the one or more disc-like accessory elements for restraining a single such accessory element or an axially aligned stack of one or more such accessory elements against upward movement relative to the cartridge ring.

Sweet teaches such a retainer clip element [Figure 1: (10)]:

(e) disposed on a side wall within a light housing [Figure 1: (1)] for engagement with outer edge portions of a top [defined as bottom surface of Figure 1: (6)] of a disc-like accessory element [Figure 1: (6)] being axially stacked within the light housing;

(f) wherein a resilient retainer element [Figure 1: (14)] extends inward from the side wall portions at an angle thereto such that portions of the resilient element closer to the bottom portion [Figure 1: (2)] of the light housing

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extend inward a distance less than portions of the resilient element farther removed from the bottom portion [Figure 1: (15)]; and

(g) whereby the resilient element [Figure 1: (14)] engages and resiliently bears inwardly against at least the upper portion or top [defined as bottom surface of Figure 1: (6)] of the accessory element for restraining the accessory element.

As mentioned above, it would have been obvious to one ordinarily skilled in the art that one could replace the retainer member of Kuchar with the retainer clip element of Sweet due to functional equivalence in providing suitable means for retaining the accessory element(s) from displacement, rotation, etc. Such a configuration is a matter of design preference, and it should further be noted that all structural limitations have been met by the above references.

7. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuchar et al. (U.S. Patent 6079992) in view of Sweet (U.S. Patent 2477705).

Kuchar discloses a media cartridge unit [Figures 12-13: (108, 116)] including:

- (a) a cartridge ring having a circular side wall [Figures 12-13: (108)] and open bottom and top portions [Figures 12-13];
- (b) a bottom support flange extending inwardly [Figures 12-13: (126); Column 6, Line 59];
- (c) a plurality of generally flat, disc-like accessory elements [Figure 12: (106); Column 6, Lines 29-32] fitting within the cartridge unit;

(d) whereby the bottom support flange supports the plurality of accessory elements [Figures 12-13]; and

(e) the side wall portions having an axial dimension sufficient in accommodating the plurality of accessory elements so that they are in an axially stacked disposition [Figures 12-13].

In addition, Kuchar teaches, "As therein shown a plurality (here three) of media accessories 106 such as, for example, a colored filter, a lens, and a louver are axially spaced within a unitary media cartridge 108, and are retained therein by the use of any suitable means such as a circular wire (not shown) received within the periphery of the cartridge [Column 6, Lines 29-35; underline added for emphasis]."

Kuchar does not specifically teach the retaining means / member(s):

(f) being secured to an inside wall of the cartridge and positioned for resilient engagement with edge portions of the uppermost one of the one or more additional accessory elements for further restraining the accessory elements against upward movement relative to the bottom of the cartridge ring;

(9a) wherein a resilient element extends inward from the side wall portions at an angle thereto such that portions of the resilient element closer to the bottom portion of the cartridge ring extend inward a distance less than portions of the resilient element farther removed from the bottom portion; and



(9b) whereby the resilient element engages and resiliently bears inwardly against at least the upper one of the one or more disc-like accessory elements for restraining a single such accessory element or an axially aligned stack of one or more such accessory elements against upward movement relative to the cartridge ring.

Sweet teaches such a retainer clip element [Figure 1: (10)]:

(f) disposed on a side wall within a light housing [Figure 1: (1)] for resilient engagement with outer edge portions of a top [defined as bottom surface of Figure 1: (6)] of a disc-like accessory element [Figure 1: (6)] being axially stacked within the light housing and for further restraining the accessory element against movement relative to the bottom of the light housing [Figure 1: (2)];

(9a) wherein a resilient retainer element [Figure 1: (14)] extends inward from the side wall portions at an angle thereto such that portions of the resilient element closer to the bottom portion [Figure 1: (2)] of the light housing extend inward a distance less than portions of the resilient element farther removed from the bottom portion [Figure 1: (15)]; and

(9b) whereby the resilient element [Figure 1: (14)] engages and resiliently bears inwardly against at least the upper portion or top [defined as bottom surface of Figure 1: (6)] of the accessory element for restraining the accessory element.

As mentioned above, it would have been obvious to one ordinarily skilled in the art that one could replace the retainer member of Kuchar with the retainer clip element of Sweet due to functional equivalence in providing suitable means for retaining the accessory element(s) from displacement, rotation, etc. Such a configuration is a matter of design preference, and it should further be noted that all structural limitations have been met by the above references.

### ***Allowable Subject Matter***

8. Claims 2-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Please include the limitations of Claim 2 into independent Claim 1. The subsequent claims should be renumbered accordingly.

9. Claims 10-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Please include the limitations of Claims 9 and 10 into independent Claim 8. The subsequent claims should be renumbered accordingly.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references have been cited to further show the state of the art pertinent to the current application, but may not be exhaustive:

US Patent 1616306 to Dake;

US Patent 6632007 to Agro.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (11/30/2004)



**JOHN ANTHONY WARD**  
**PRIMARY EXAMINER**